

## **REMARKS**

Claims 1-73 are pending in the application. Claims 41-53, 57, 59, 61, 63, 65, 67, 69, and 71-73 are withdrawn from consideration as being drawn to a non-elected group. Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 have been rejected under 35 U.S.C. §112, second paragraph; 35 U.S.C. §§ 102(b) and (f); and 35 U.S.C. §103(a). Claims 1, 19, 20, 22, 24, and 55 have been amended to correct for informal defects and to correct for improper dependencies. Support for the amendments may be found in the specification and claims as originally filed. There is no new matter included in the amendments.

### **35 U.S.C. § 112 Rejections**

Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 have been rejected under 35 U.S.C. § 112 for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Examiner has specifically rejected claim 1 for lacking clear antecedent basis for “present in said chamber” and suggests amending the claim to recite “already present in said chamber.” Applicants have amended the claim to delete “present.” As amended, “another cell or cell-like structure in said chamber” is in proper form as written.

Claim 22 has been rejected because the phrase “is used in step” is unclear. Applicants have deleted the phrase “is used in step” from Claim 22 to make the claim clearer.

The Examiner has rejected claims 23 and 25 for lacking proper antecedent basis for the term “the chamber.” “[T]he chamber” has proper antecedent basis from line 3 of claim 1 and the claim is in proper form as written.

Claims 24 – 27 have been rejected for lacking antecedent basis for “hollow microelectrode.” Applicants have amended claim 24 to provide proper antecedent basis for

“microelectrode.” Claims 25 – 27, which depend from claim 24 are now also in proper form by virtue of their dependency.

Claims 19, 28, and 30 were rejected for lacking antecedent basis for “microelectrode.” Claim 1 has been amended to correct this error.

Claim 55 was rejected for depending from claim 37. Claim 55 has been amended to depend from claim 41 to correct this defect.

Thus, as amended, the claims are believed to be in condition for allowance. Accordingly, Applicants request the withdrawal of the § 112 rejections and allowance of the claims.

#### **Stromberg et al Was Derived From the Instant Inventors**

Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 have been rejected as being anticipated by Stromberg et al, *Microfluidic device for combinatorial fusion of liposomes and cells*, Analytical Chemistry, November 30, 2000, v. 73, no. 1, pages 126-130 (Stromberg et al).

In this regard, Applicants file herewith a Rule 132 Declaration. The Declaration declares that the authors of the Article derived their subject matter from the inventor of the application. Applicants believe that the Declaration overcomes the rejection, and accordingly request the withdrawal of the rejection and allowance of the claims.

#### **Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 Are Novel Over Muller et al**

Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 have been rejected as being anticipated by Muller et al, WO 0037628 and U.S. 6,492,175 (Muller) under 35 U.S.C. §§ 102 (b) and (e). The Examiner asserts that Muller discloses a microsystem for cell permeation and cell fusion wherein on a chip is located channels and a chamber for electroporation/fusion. Applicants respectfully traverse the rejection.

Nowhere does Muller disclose the method for electromanipulation or the apparatus for electromanipulation of the instant invention. Muller does not disclose, teach or suggest the “one or more sample containers” required by the claims. Thus, on this basis alone, Applicants claims are novel over Muller et al. Accordingly, Applicants request withdrawal of the rejection and allowance of the claims.

**Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 Are Non-Obvious Over Muller In View Of  
Wu et al., Buican et al, Stice et al., and Steenbakkors**

Claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 have been rejected for being unpatentable over Muller in view of Wu et al., U.S. 6,221,677 (Wu), Buican et al., U.S. 5,100,627 (Bucian), Stice et al., U.S. 5,945,577 (Stice), and Steenbakkors, U.S. 6,020,170 (Steenbakkors) under 35 U.S.C. § 103(a). Applicants traverse the rejection.

As discussed above, at a minimum, Muller does not teach or suggest the “one or more sample containers” required by the claims.

Neither Wu, nor Buican, nor Stice, nor Steenbakkors, alone or in combination, cure this defect of Muller. Wu, Bucian, Stice, and Steenbakkors do not teach or suggest the “one or more sample containers” required by the claims. Thus, claims 1-40, 54-56, 58, 60, 62, 64, 66, 68, and 70 Are Novel Over Muller in view of Wu, Buican, Stice, and Steenbakkors. Accordingly, Applicants request withdrawal of the rejection and allowance of the claims.

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### CONCLUSION

In light of the above remarks, Applicants respectfully requests early consideration and allowance of the subject application.

Attached is a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to extend the period for response for two (2) months, up to August 22, 2004, along with the necessary fee. Please charge any additional fees required in connection with the papers transmitted herewith to Deposit Account No. 04-1105.

Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Respectfully submitted,

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